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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,264	02/01/2002	Bryan Scott	Scott.00003	9429

7590 10/17/2003

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EXAMINER	
CHEN, ALAN S	

ART UNIT	PAPER NUMBER
2182	2

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Please find below and/or attached an Office communication concerning this application or proceeding.

PNG

Office Action Summary	Application No.	Applicant(s)	
	10/051,264	SCOTT ET AL.	
	Examiner	Art Unit	
	Alan S Chen	2182	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 01 February 2002 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,2,4,5 and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,11,12,13 and 7, respectively, of copending Application No. 10,053,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because the port coupled to the IDS in Application No. 10,051,264 makes the IDS a system when attached to peripheral devices via the port. Furthermore, the IDS is a system in-and-of itself because it is comprised of several components. In addition, a bus will always require a bus interface and similarly, a port is always used as an input/output to another component (in this context, a device).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims are provisionally rejected under the judicially created doctrine of double patenting over claims of copending Application No.. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: an IDS which is an system in and of itself comprising a co-processor converting a hand held-based device data element into a device enabled data element; a bus interface coupling the bus of the hand held computer to the docking station (with the co-processor); and a port for coupling a device to the docking station (with the co-processor). The device coupled to the system wherein the device could be a monitor or memory. The bus can be a wireless connection. The device coupled to the IDS is integrated (co-located) within the IDS.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "160" has been used to designate multiple different ports. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 158 in Fig. 1, 200 and 218 in Fig. 2. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office

action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: acronym "IDS" should be defined upon first use on page 3, line 16, immediately after the terms "intelligent docking station".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by No. 6,286,060 to DiGiorgio et al. (hereafter DiGiorgio).

9. In reference to claims 1, DiGiorgio discloses the IDS system comprising:

A docking station (Fig 4, the expansion unit) having a co-processor (Fig. 9, element 900 and Column 5, lines 40-54) capable of converting a hand held based data element into a device enabled data element; a bus (Fig. 4, element 408) that couples the docking station to a handheld computer (Fig. 8, element 100); and a device (Fig. 8, element 808) coupled to the docking station.

10. In reference to claims 2-4, DiGiorgio discloses the IDS system of claim 1, wherein the device could be a monitor, mouse or memory (Fig. 4, elements 415, 416 and 417). DiGiorgio

describes the ability to interface serial, parallel, USB, etc., type devices, under which the monitor, mouse or memory classify.

11. In reference to claim 5, DiGiorgio discloses the IDS system of claim 1, wherein the bus is a wireless connection (Fig. 4, element 408).

12. In reference to claim 6, DiGiorgio discloses the IDS system of claim 1, wherein the device is coupled to the docking station is integrated with the IDS (Fig. 8, element 804), here the device being the controller.

13. In reference to claim 7 and 8, DiGiorgio discloses the IDS system of claim 1, further comprising a communication driver integrated with the IDS (Fig. 9, element 900), the communication driver capable of converting signals between a bus-enabled data element (Fig. 8, element 808) and an IDS enabled or handheld (Fig. 8, element 100) data element (Column 5, lines 40-54).

14. In reference to claim 9, DiGiorgio discloses the IDS of claim 1, wherein the IDS comprises an IDS coprocessor (Fig. 9, element 900 and Column 5, lines 40-54) having an IDS OS (Column 2, lines 42-57 and Column 5, lines 40-53) capable of directing a top-level device driver (Fig. 8, element 101) and a low-level device driver (Fig. 8, element 804), wherein the low-level device driver is enabled to convert between a device data element and an IDS enabled data element.

15. In reference to claim 10, 11 and 12, DiGiorgio discloses a software system (Fig. 4-7) for enabling a handheld computer (Fig. 8, element 100) to use an intelligent docking station (Fig. 9, element 9), the system comprising:

An IDS operating system (Column 2, lines 42-57 and Column 5, lines 40-53); A low-level device driver in communication with the IDS operating system (Fig. 8, element 804); A top-level device driver in communication with the IDS operating system (Fig. 8, element 101); and a communication driver capable of converting signals between a bus-enabled data element and a handheld data element (Column 5, lines 40-53). Note that converting signals entails formatting and assembling data elements (which are transferred as binary signals to and from an initiator and target).

16. In reference to claims 13, 14 and 19, DiGiorgio discloses the software system of claim 12, further comprising a wireless bus coupled between the communication driver and a second communication driver located in the handheld (Fig. 4, element 408). Bluetooth is a wireless network and its popularity with handheld devices can be seen with the integrated Bluetooth PDAs out on the market.

17. In reference to claim 15, DiGiorgio discloses the software system of claim 13, further comprising a top-level device driver (Fig. 3, element 301) coupled between the second communication driver (Fig. 9, element 900) and a handheld OS (Fig. 3, element 100 and 300).

18. In reference to claim 16-18, DiGiorgio discloses the software system of claim 12, where the low-level device driver (Fig. 4, elements 415-417 and Fig. 9, elements 808) is a keyboard, monitor or memory driver. DiGiorgio describes the ability to interface serial, parallel, USB, etc., type devices, under which the monitor, mouse or memory classify.

19. In reference to claim 20, DiGiorgio discloses the software system of claim 12, wherein the bus is a fiber optics based bus (Column 7, lines 22-35).

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to PDAs and docking stations:

U.S. Pat. No. 5,668,977 to Swanstrom et al.

U.S. Pat. No. 6,044,215 to Charles et al.

U.S. Pat. No. 6,266,539 to Pardo

U.S. Pat. No. 6,309,230 to Helot

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S Chen whose telephone number is 703-605-0708. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

ASC
10/9/2003

JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100